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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,649	06/24/2003	Lawrence L. Bell		1296

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Lawrence L. Bell  
18 Farmington Court  
Chevy Chase, MD 20815

EXAMINER
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WEIS, SAMUEL

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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07/09/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/601,649

**Applicant(s)**

BELL, LAWRENCE L.

**Examiner**

SAMUEL S. WEIS

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This is in response to the Applicant's amendment filed on April 3, 2008. Claims 1-6 and 8-10 have been amended. New claims 11-13 have been added. Claims 1-13 have been examined.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

3. The dependent limitations of claims 4 and 5 are taken to be admitted prior art because the Applicant inadequately traversed the Examiner's assertion of Official Notice. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate.

4. The Declaration of Lawrence Bell filed on April 3, 2008, with Exhibits A, B, and C, under 37 CFR 1.131 has been considered but is ineffective to overcome the Davis reference.

5. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Davis reference. While conception is the mental part of

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the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Davis reference.

The Applicant's Exhibits, labeled A, B, and C, do not establish either conception or reduction to practice the invention prior to the effective date of the Davis reference. Exhibit A details only a single paragraph letter from the Applicant to a potential client. Exhibit A mentions the existence of a memo detailing the GREIT plan that is attached to the letter; however, this memo was not included in the Applicant's affidavit. This memo would be quit helpful for establishing conception and reduction to practice. Exhibits B and C are short emails with vague mentions of potential applications of Applicant's invention. Therefore, further evidence is required from the Applicant in order to overcome the date of the Davis reference.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3 and 6-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis, U.S. Pat. App. Pub. No. 20010049612.

As to claim 1, Davis discloses a method for identifying and administering a deferred award plan for the benefit of an employee through a computer system in order to reduce individual income of said employee, said method comprising the steps of: identifying at least one employee of an employer in said deferred award plan (abstract); retrieving financial data related to a deferred compensation plan and to an employee welfare benefit plan corresponding to said identified employee (§0019); computing a spread or gain associated with said deferred compensation plan (§0019); establishing an asset for FASB or IASB purposes with said spread or gain (§0009); purchasing an individual or group life insurance policy having a predetermined benefit, said individual or group life insurance policy combining features of said deferred compensation plan and said employee welfare benefit plan §0031-33); enabling under control of said employer said employer to purchase investments through said purchased individual or group life insurance policy (§0009) creating an asset on the books of the company (claim 14); and

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allowing said employee to borrow funds accumulated in said individual or group life insurance policy up to a limit set forth in an endorsement, said limit reflecting a level of compensation according to said deferred compensation plan (§0051).

As to claim 2, Davis discloses converting said financial data to a deferred award instrument plan format (§0024).

As to claim 3, Davis discloses converting data related to said deferred compensation to a deferred award instrument plan format (§0024)

As to claim 6, Davis discloses a system for implementing a deferred award plan (abstract) comprising: a processor; memory operationally attached to said processor; an input device operationally attached to said processor; a display device operationally attached to said processor (§0019);

an identifier for identifying at least one employee of an employer in said deferred award plan (abstract);

a retrieving unit for retrieving financial data related to a deferred compensation plan and employee welfare benefit plan (§0019);

a processor for computing a spread or gain associated with at least one of said deferred compensation and said employee welfare benefit plans (§009);

an asset establishment unit for establishing an asset on the company books with said spread or gain (claim 14);

purchasing unit for purchasing an individual or group life insurance policy having a predetermined benefit (§0019);

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a trading unit for enabling under control of said employer or employee said employee to purchase stock or other investments through said purchased life insurance benefit (§0051);

an executing unit for executing a co-ownership endorsement (§0051);

a loan unit allowing said employee to borrow funds accumulated in said life insurance policy up to a limit set forth in said co-ownership endorsement said limit reflecting said employee's deferred compensation or asset accumulation (§0051).

As to claim 7, Davis discloses a converter for converting said deferred compensation data to a deferred award instrument plan format (§0023-24).

As to claim 8, Davis discloses a second converter for converting said human resource data to a deferred award instrument plan format (§0023-24).

As to claims 9 and 10, Davis discloses wherein said employee welfare benefit plan is an employee welfare benefit plan (§0005).

As to claim 11, Davis discloses wherein estate taxes of said employee are reduced (§0007).

As to claim 12, Davis discloses allowing said employer to borrow funds accumulated in said individual or group life insurance policy (§0051).

As to claim 13, Davis discloses wherein said loan unit allows said employer to borrow funds accumulated in said life insurance policy (§0051).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Examiner's Official Notice.

As to claims 4 and 5, Davis does not explicitly disclose inputting weighing indicators corresponding to said model factors and displaying at least a predetermined portion of said retrieved and stored data based on said weighing indicators.

However, the Examiner takes Official Notice that weighing indicators are old and well known in the financial arts. It would have been obvious at the time of the Applicant's invention to weigh various factors differently in order to model the data appropriately.

**Conclusion**

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel S. Weis whose telephone number is (571) 272-1882. The examiner can normally be reached on 8:30 to 5, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Stefanos Karmis/

Primary Examiner, Art Unit 3693